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EXAMINER

BUTLER, MICHAEL E

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,699

Applicant(s)

BIGUS ET AL.

Examiner

Michael Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on 02/04/2004

2a) ☒ This action is **FINAL**.

2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) 24-26 and 40-49 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) 24-26 and 40-49 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim of priority as a national stage 371 application of application of PCT/DE00/02191 filed 6/29/00 which claims priority to application 199 35 634.3 filed 07/29/1999 in Germany is acknowledged.

Drawings

2. New drawings will be required contingent upon allowance because the drawings were declared informal by the applicant.

Election/Restriction

3. Applicant's election of invention II with traverse of the restriction requirement in Paper No. 6 is acknowledged and made final.

Examiner notes the amendment of the elected special technical features into claims 24-36 and the removal of the nonelected special technical feature into claims 24-36.

Claim Rejections - 35 USC § 101

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 24-36 are rejected under 35 U.S.C. 101 as being directed at two differing and distinct statutory classes of invention-process and machine. Dependent method claims must depend from method claims-not apparatus claims.

Claim Rejections - 35 USC § 112

6. Claims 24-26 and 40-49 are rejected under 35 U. S. C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not apparent what constitutes cooperating regarding applicant's side wall cooperating with a bottom.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 47-48, 43-44, and 24-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Castner, Sr. et al. '857 which discloses a dispenser of cylindrical objects readily suited for capillary dispensing including:

(Re: cl 47) A dispenser comprising:

bottom 16

side wall 15 cooperating with bottom

second side wall 15 at and parallel to a first separation 40 fig 9

first separation larger than capillary length (fig 9)

top cooperating with first and second side walls and parallel to a second separation from the bottom

top having an elongated opening with width greater than tape width (39 fig 9; 23)

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(Re: cl 48) elongated opening extends along a central portion of elongated receptacle (fig 1)

(Re: cl 44) dispenser structured for axial removal of capillaries (33)

(Re: cl 45) dispensing location has opening level with capillary penetrating (33)

(Re: cl 43) Means for winding capillaries about an axle at end of is approximately diameter of capillary (63 fig 11).

9. Claims 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Jarhoff et al.

which discloses:

(Re: cl 47) A dispenser comprising:

bottom 14

side wall cooperating with bottom 15

second side wall at and parallel to a first separation 13

first separation larger than capillary length 40

top cooperating with first and second side walls and parallel to a second separation from the bottom 17

top having an elongated opening with width greater than tape width 40

(Re: cl 48) elongated opening extends along a central portion of elongated receptacle (40 fig 1).

10. Claims 47-48 and 43 and 24-37 are rejected under 35 U.S.C. 102(b) as being anticipated

by Mochida which discloses:

(Re: cl 47) A dispenser comprising:

bottom (below 1)

side wall cooperating with bottom (below 1)

second side wall at and parallel to a first separation (far side of slot 18)

first separation larger than capillary length (above tape on fig 1)

top cooperating with first and second side walls and parallel to a second separation from the bottom, top having an elongated opening with width greater than tape width (above tape on fig 1)

(Re: cl 48) elongated opening extends along a central portion of elongated receptacle (above tape on fig 1)

(Re: cl 43) Means for winding capillaries about an axle (16 FIG 2 about 15) at end of 7 is approximately diameter of capillary.

11. Claims 47-48, 44-45, and 24-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher which discloses a dispenser for cylindrical objects readily amenable to capillary dispensing including:

(Re: cl 47) A dispenser comprising:
bottom 6
side wall 8 cooperating with bottom
second side wall 18 at and parallel to a first separation 28
first separation larger than capillary length 28
top cooperating with first and second side walls and parallel to a second separation from the bottom 12
top having an elongated opening (fig 2) with width greater than tape width (m)
(Re: cl 48) elongated opening extends along a central portion of elongated receptacle (fig 2)
(Re: cl 44) dispenser structured for axial removal of capillaries (18 fig 1)
(Re: cl 45) dispensing location has opening level with capillary penetrating (28).

12. Claims 47-48, 43 and 24-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Mochida which discloses a dispenser for capillaries including:

(Re: cl 47) A dispenser comprising:
bottom (below 1)
side wall cooperating with bottom (below 1)
second side wall at and parallel to a first separation (far side of slot 18)
first separation larger than capillary length (above tape on fig 1)
top cooperating with first and second side walls and parallel to a second separation from the bottom, top having an elongated opening with width greater than tape width (above tape on fig 1)
(Re: cl 48) elongated opening extends along a central portion of elongated receptacle (above tape on fig 1)
(Re: cl 43) Means for winding capillaries about an axle (16 FIG 2 about 15)
at end of 7 is approximately diameter of capillary.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 24-39, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida in view of Keenan et al. which discloses the elements previously discussed and further discloses:

(Re: cl 47) A dispenser comprising:

bottom (below 1)

side wall cooperating with bottom (below 1)

second side wall at and parallel to a first separation (far side of slot 18)

first separation larger than capillary length (above tape on fig 1)

top cooperating with first and second side walls and parallel to a second separation from the bottom, top having an elongated opening with width greater than tape width (above tape on fig 1)

(Re: cl 48) elongated opening extends along a central portion of elongated receptacle (above tape on fig 1)

(Re: cl 43) Means for winding capillaries about an axle (16 FIG 2 about 15)
at end of 7 is approximately diameter of capillary;

15. Claims 24-36, 47-48. and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida in view of Keenan et al. which discloses the elements previously discussed and further discloses:

Keenan et al. discloses any elements that Mochida does not explicitly disclose including:
separating tape less than half the width of the capillary length (66 vs. 30);

disposing capillaries in parallel alignment on tape at separations less than diameters (c5 L 5-45 with fig 1 & 2).

It would have been obvious at the time of the invention for Mochida to use a narrower tape width for ease of removal as taught by Keenan et al.. It would have been obvious at the

time of the invention for Mochida to place capillaries proximate each other within a diameter width for compact storage as taught by Keenan et al..

16. Claims 24-36, 40-42, and 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoboen (University of Washington on 1449) in view of Keenan et al. which discloses the elements previously discussed and further discloses:

(Re: cl 47) A dispenser comprising:
bottom (22)

side wall cooperating with bottom (20)

second side wall at and parallel to a first separation (36)

first separation larger than capillary length (as seen with loading the capillary via the top) top cooperating with first and second side walls and parallel to a second separation from the bottom, top having an elongated opening (18)

(Re: cl 48) elongated opening extends along a central portion of elongated receptacle (26)

(Re: cl 49) consisting essentially of a first opening strip and a second opening strip extending substantially parallel to and at a separation from first opening strip

(Re: cl 40) slider (46)

(Re: cl 41) means for loading capillaries into slotted guide (32)

(Re: cl 42) diameter of discharge corresponds to the diameter of the capillaries (48 fig 1)

(Re: cl 44) dispenser structured for axial removal of capillaries (end of 48)

(Re: cl 45) dispensing location has opening level with capillary penetrating (exit from end of 48)

(Re: cl 46) opening diameter corresponds to diameter of capillaries (48 corresponds in diameter to capillaries).

Keenan et al. discloses any elements that Sjoboen does not explicitly disclose including:

Opening width greater than tape width (c5 L 18-27)

adhesive tape removable from capillaries when supported by guide tape less than half the width of the capillary length (66 vs. 30);

disposing capillaries in parallel alignment on tape at separations less than diameters (c5 L 5-45 with fig 1 & 2).

It would have been obvious at the time of the invention for Sjoboen to use a narrower tape width to keep capillaries together through installation with subsequent ease of removal of capillaries as taught by Keenan et al.. It would have been obvious at the time of the invention for

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Sjoboen to place capillaries proximate each other on the tape within a diameter width for compact storage as taught by Keenan et al..

Response to Amendments and Arguments

17. The applicant's arguments have been fully considered but they are unpersuasive in overcoming the rejections evidenced by Sjoboen (University of Washington on 1449) in view of Keenan et al., and Mochida in view of Keenan et al..

The applicant's arguments have been fully considered but they are unpersuasive in overcoming the rejections under 35 U.S.C. 101. Applicant's cited section is limited to method claims dependent from an otherwise allowable base apparatus claim and relates to rejections under 35 U.S.C. 112 second and forth paragraphs-not 35 U.S.C. 101. "The dichotomy between process and product classes of invention has also been recognized and noted". Ex parte Lyell, 17 USPQ2d 1548,1552 (BdPatApp&Int, 1990) in the following discussion "A method or process... is an act or a series of acts and from the standpoint of patentability must distinguish over the prior art in terms of steps, whereas a claim drawn to apparatus must distinguish in terms of structure... The Patent Act of 1952 did not abolish the then existing different classes of invention. It reaffirmed the same by Section 101 of USC 35". Ex parte Lyell at 1552 citing Ex Parte Forsyth, 151 USPQ 55, 56 (Bd. of Appeals 1965); see also MPEP 2114 for the analogous rule on the unavailability of functional limitation solely as the distinction in apparatus claims from prior art.

Applicant's amendments were effective in overcoming the rejections under 35 U.S.C. 112 first paragraph. While applicant did overcome rejections under 35 U.S.C. 112 second paragraph, new indefinite claim language has been introduced.

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Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.

Michael E. Butler

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Examiner

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